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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,915	02/14/2002	Anna Lee Tonkovich	13007B	1868

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SAN FRANCISCO, CA 94129-0230

EXAMINER
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LEUNG, JENNIFER A

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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12/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Advisory Action Before the Filing of an Appeal Brief

Application No. 10/076,915	Applicant(s) TONKOVICH ET AL.
Examiner Jennifer A. Leung	Art Unit 1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

## AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: 5 and 98.  
Claim(s) objected to: 30, 31, 80 and 81.  
Claim(s) rejected: 1-4, 6-29, 75-79, 82-97, 99 and 100.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

## AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

## REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

### **Continuation of Item 3.**

Applicant's proposed amendments to claims 1, 5, 10, 13, 24, 27 and 87, which replace the previously presented limitation of "a flow path that travels *parallel* to the shim thickness" with the new limitation of "a flow path that travels *perpendicular* to the shim thickness", change the scope of the claims and raise a new issue that requires further search and/or consideration. Similarly, the amendment made to the specification requires further consideration.

Applicant's proposed amendment to claim 10, which calls for the newly added feature of, "a third flow path... wherein the first flow path, the second flow path, and the third flow path are each in alternating parallel rows wherein the second flow path is disposed between the first and third flow paths; wherein heat is exchanged between the first and second flow paths and heat is exchanged between the third and second flow paths," raises a new issue that requires further search and/or consideration.

Applicant's proposed amendment to claim 13, which deletes the previously presented Markush elements of adsorbing, compressing, expanding, absorbing, vaporizing, condensing, and combinations thereof, changes the scope of the claims, and thereby necessitates further search and/or consideration.

Applicant's proposed amendment to claim 27, which deletes the previously presented Markush elements of reacting, compressing, expanding, vaporizing and condensing for the first unit operation, changes the scope of the claims, and thereby necessitates further search and/or consideration.

Applicant's proposed amendment introduces a new claim 101 that recites, "each parallel row comprises plural, parallel flow paths," which is a newly claimed feature that requires further search and/or consideration.

### **Continuation of Item 11.**

The request for reconsideration has been fully considered, but it does not place the application in condition for allowance for the same reasons set forth in the final Office Action.

In addition, Applicant (at page 18, first paragraph) argues,

"The "after final" status of the application is improper because the new rejections were not necessitated by an amendment to the claims. Claim 13 was essentially unamended since it essentially incorporated the limitations of claim 14; in other words, claim 13 (in the amendment of April 17, 2007) was essentially the same as claim 14 of the prior claim set.

Furthermore, unamended claims 75, 78 and 79 (in the amendment of April 17, 2007) have been rejected in view of a newly applied reference (Bottcher). The rejection of these claims was not necessitated by any amendments."

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The Examiner respectfully disagrees and maintains that the finality of the previous Office Action was proper.

With respect to claim 13, the non-final Office Action mailed November 17, 2006 rejected claims 13 and 14 under 35 U.S.C. 102(a) as being anticipated by Symonds (WO 01/35043). The unit operation of claim 14 that was disclosed in the Symonds reference was a "reaction".

In response to the non-final Office Action, Applicant's amendment on April 17, 2007 incorporated some of the Markush elements of claim 14, including distilling, separating, vaporizing, compressing, and condensing, and further added the new Markush elements of expanding, absorbing and adsorbing. However, the previously presented "reaction" limitation, specifically disclosed by Symonds, was deleted from the claims. Thus, Applicant's amendment necessitated a new search and a new ground of rejection in the final Office Action mailed July 24, 2007. Furthermore, Applicant's amendment changed the scope of the claims which previously depended from claim 13, but not claim 14.

With respect to dependent claims 75, 78 and 79, each of said claims ultimately depend from independent claim 1. Applicant's amendment on April 17, 2007 introduced additional limitations into the independent claim, including the newly recited feature of "a common header". Thus, Applicant's amendment necessitated a new search and new ground(s) of rejection with respect to claims 1, 75, 78 and 79 in the final Office Action mailed July 24, 2007.


\* \* \*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Leung whose telephone number is (571) 272-1449. The examiner can normally be reached on 9:30 am - 5:30 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jal  
November 30, 2007

  
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